

DETAILED ACTION

Response to Amendment

1. Applicant's response to the office action filed on April 18, 2008 has been entered. The claims pending in this application are claims 1, 3-17, and 21. Rejection and/or objection not reiterated from the previous office action are hereby withdrawn in view of applicant's amendment filed on April 18, 2008.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3-17, and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 1 is rejected as vague and indefinite in view of the phrase "said 3' recognition sequence being combined with partially overlapping a DNA methylation recognition sequence" in step a) of the claim because it is unclear who is partially overlapped with a DNA methylation recognition sequence. Furthermore, it is unclear that the phrase "cleaving each desired DNA unit with said restriction enzyme, such that each desired DNA unit maintains said 3' DNA methylase recognition sequence" is a method step or is a phrase in "wherein" phrase to describe cleaving property of each desired DNA unit. Please clarify.

5. Claim 1 recites the limitation "the same restriction enzyme" in step a) of the claim. There is insufficient antecedent basis for this limitation in the claim because there is no phrase

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“restriction enzyme” before “the same restriction enzyme”. Note that “restriction enzyme recognition sequence” is not considered to be identical to “restriction enzyme”. Please clarify.

6. Claim 1 is rejected as vague and indefinite in view of steps e) to g). Since the cleaved ligated product produced from step f) in step g) is different from the cleaved ligated product from step d) in step e), in view of steps e) to g), it is unclear why step g) can be performed by repeating steps e) and f) using the cleaved ligated product from step d) in step e). Please clarify.

7. Claim 4 is rejected as vague and indefinite in view of steps e) to g). Since the cleaved ligated product produced from step f) in step g) is different from the cleaved ligated product from step d), in view of steps e) to g), it is unclear why step g) can be performed by repeating steps e) and f) using the cleaved ligated product from step d) in step e). Please clarify.

8. Claim 5 is rejected as vague and indefinite because it is unclear that a restriction enzyme in the claim is identical to a restriction enzyme in claim 1 or not. Please clarify.

9. Claim 8 is rejected as vague and indefinite because it is unclear that the ligated product in the claim means the methylated ligated product from step c) or the cleaved ligated product from step d) or the methylated next ligated product from step e) or the cleaved ligated product from step f). Please clarify.

10. Claim 9 is rejected as vague and indefinite in view of steps e) to g). Since the next cleaved product in line 2 of step f) is produced from step e) and is different from the next cleaved product produced from last line of step f) in step g), it is unclear why step g) can be performed by repeating step f) using the cleaved ligated product from step e). Please clarify.

11. Claim 10 is rejected as vague and indefinite in view of steps d) to f). Since the cleaved product in line 1 of step e) is produced from step c) and is different from the cleaved product

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produced from last line of step e) in step f) is different from, it is unclear why step f) can be performed by repeating steps d) and e) using the cleaved product produced from step c) in line 1 of step e). Please clarify.

12. Claim 13 is rejected as vague and indefinite because it is unclear that a desired DNA unit is identical to the cleaved dephosphorylated first desired DNA unit in step c) or the cleaved dephosphorylated next desired DNA unit in step c) or not. Please clarify.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. No claim is allowed.

15. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30

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(November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

/Frank W Lu /
Primary Examiner, Art Unit 1634
June 19, 2008